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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,197	10/23/2003	Joseph M. Steckling	5833	8430

44341 7590 12/14/2004

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EXAMINER

SCHWARTZ, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/692,197

Applicant(s)

STECKLING, JOSEPH M.

Examiner

Christopher P. Schwartz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1 line 7 "said second slidable member" lacks antecedent basis.

Lines 9 and 10 are unclear. The second slidable member has been doubly claimed. How does this member enable itself (as claimed) to be axially slidable into chamber 31?

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson '269 in view of Cope et al. or Danneker.

Regarding claim 1 Peterson shows a shock adapter, as broadly claimed, in figure 9 including a housing 314, first and second end caps 324,325 and a slidable member 312 extending through the end caps.

Peterson lacks showing the slidable member formed of two separate parts.

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The references to Danneker or Cope et al. show it is well known to make singular parts plural. Note the separate rods in Cope et al. at 28 and at 22,24 in Danneker.

Note the close similarity of the device of Peterson to that of Danneker.

One having ordinary skill in the art at the time of the invention would have found it obvious to have made the rod 312 of Peterson into two halves, as taught by either Danneker or Cope et al., simply to adapt the device to different applications or structures. Note for instance the different design shown in figure 4 of Peterson.

Regarding claim 2 it is notoriously well known in the art to provide external threads on the housing so that it can be mounted to a supporting structure. Nevertheless it appears that Peterson shows this to mount the end caps 324,325. As broadly claimed the requirements of claim 2 are considered to be met.

Regarding claims 3-6, as modified above, these requirements are met.

Regarding claims 7,8 the limitations "to retain" and "for receiving.." are statements of intended use. Therefore the cavity shown at 322 of Peterson is considered to be sufficient to retain a one way shock absorber.

Regarding claim 10 note the stops taught by either Danneker at 20 or Cope at 48. To have used such stops in the device of Peterson, as modified, would have been obvious for the reasons given above.

5. Claim 9 rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Cope as applied to claim 1 above, and further in view of Cotter.

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Regarding claim 9 Cope is relied upon to also show it is known to provide the threads on the internal surface of the cylinder for mounting the end caps in an alternative way to that of Peterson.

Cotter is relied upon to show it is well known to provide external threads 46 on the exterior of the housing. Such threads could be used to secure the housing to a mounting structure.

6. Claims 11-18 rejected under 35 U.S.C. 103(a) as being unpatentable over Cope et al. in view of Bartesch et al. or Shinozaki et al..

Regarding claim 11 Cope et al. shows a two way "shock adapter" .

Lacking is a specific discussion of the capability of converting a one way absorber into a two way absorber.

However note the discussion in col 1 of this reference.

The references to Bartesch et al. or Shinozaki et al. are relied upon to illustrate one way absorbers.

Therefore, in light of the discussion in col 1 of Cope et al. the device may be considered to be a shock adapter for converting (a statement of intended use) a one way shock absorber as shown by either Bartesch et al. or Shinozaki et al. into a two way shock absorber, as broadly claimed.

Note the first and second slidable members at 28.

Regarding claims 12-18 as can easily be seen in the drawings, and due to the statements of intended use regarding the shock absorber these requirements are met, since the device of Cope et al. is capable of meeting the claimed requirements.

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***Allowable Subject Matter***

7. Claims 19-20 are allowed.

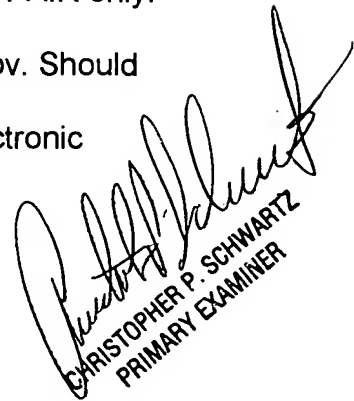
***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references cited have been cited for showing other well known types of dampers/absorbers.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Schwartz whose telephone number is 703-308-0576. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
CHRISTOPHER P. SCHWARTZ  
PRIMARY EXAMINER

Cps  
12/8/04